REMARKS

This Amendment and Response is filed in reply to the Final Office Action dated August 13, 2004 and the Advisory Action dated December 3, 2004. In said Advisory Action, the Examiner indicated that the amendments to the claims in Applicants' Response filed November 15, 2004 would not be entered. Thus, Applicants base this Response on the status of the claims as of the Final Office Action dated August 13, 2004.

In this Response, Applicants amend claims 7, 12, 33, 38, add new claims 55 and 56, cancel claims 11 and 37 without prejudice, and traverse the Examiner's rejection of Applicants' claims. Amendments to the claims are not an acquiescence to any of the rejections. Furthermore, silence with regard to any of the Examiner's rejections is not an acquiescence to such rejections. Specifically, silence with regard to Examiner's rejection of a dependent claim, when such claim depends from an independent claim that Applicants consider allowable for reasons provided herein, is not an acquiescence to such rejection of the dependent claim(s), but rather a recognition by Applicants that such previously lodged rejection is moot based on Applicants' remarks and/or amendments relative to the independent claim (that Applicants consider allowable) from which the dependent claim(s) depends. Furthermore, any amendments to the claims are being made solely to expedite prosecution of the instant application. Applicants reserve the option to further prosecute the same or similar claims in the instant or a subsequent application. Upon entry of the amendments, claims 1-2, 4-10, 12-28, 30-36, 38-49, and 51-56 are pending in the present application.

Applicants amend claims 7 and 33 to change the word "viewing" to "presenting" to make it consistent with the language used in independent claims 1 and 27, upon which claim 7 and 33 respectively depend.

The Examiner objected to claims 11-12, and 37-38 as being dependent upon a rejected base claim, but indicated that these claims would be allowable if rewritten in independent form to include all the limitations of the base claims and any intervening claims. Applicants thank the Examiner for recognizing the allowable subject matter defined by these claims.

Applicants accordingly add new allowable independent claims 55 and 56, corresponding to cancelled claims 11 and 37, respectively. The new independent claims include the limitations

of the base claims and the intervening claims, as requested by the Examiner. Additionally, Applicants amend claims 12 and 38 to make them dependent on new claims 55 and 56 respectively.

However, in the Advisory Action, the Examiner stated claim 56, as proposed in Applicants' Response filed November 15, 2004, was directed to non-statutory subject matter because it merely claims "a computer program product". Applicants' new claim 56 provided in this Response is directed to a computer program product *stored in a computer-readable medium*, with each of limitations reciting that the computer product comprises *machine executable code.*

Claims 1-2, 4-28, 30-49, and 51-54 were rejected under 35 U.S.C. §103(a) as being unpatentable over Contois (U.S. Patent No. 5,864,868) in view of Arons et al. (U.S. Patent No. 6,529,920) and further in view of Kunieda et al. (U.S. Patent No. 6,771,875).

As Examiner knows, and based at least on MPEP 2143, a *prima facie* case of obviousness under 35 U.S.C. 103(a) requires (1) a suggestion or motivation in the references themselves or generally known in the art, to combine the references, (2) a reasonable expectation of success to combine, and (3) *a teaching, via the combination, of all the claimed limitations* [emphasis added].

Applicants' independent claim 1 discloses a method executed in a computer system for selecting a multimedia presentation comprising providing a plurality of multimedia presentations in accordance with predetermined criteria, providing one or more multimedia data items, *each of said one or more multimedia data items being a duplicate of a portion of a corresponding one of said plurality of multimedia presentations*, presenting said one or more multimedia data items using a browser, the one or more multimedia data items being presented separately from said plurality of multimedia presentations, controlling direction and speed of the presenting of the one or more multimedia data items, selecting a first of said one or more multimedia data items, and transferring control to machine executable code associated with a first of said plurality of multimedia presentations corresponding to said first multimedia data item.

The Applicants agree with the Examiner that the combination of Contois and Arons does not teach the Applicants' claimed feature of *each of said one or more multimedia data items*

being a duplicate of a portion of a corresponding one of said plurality of multimedia presentations (page 4, 1ˢᵗ paragraph of the Office Action). The Applicants, however, disagree with the Examiner's assertion that Kunieda teaches this feature.

Kunieda describes a method for accessing video information using a video index having a tree structure comprising of objects representing frame information, sound information, segment information, and package information (see abstract). Frame information objects, representing the frames comprising the video in question, can be added to the video index structure using algorithms for detecting changes in the background color, or by using other types of frame detection algorithms (col. 11, line 47 to col. 12, line 6). A particular frame may be sub-divided into additional frame objects (and other types of information objects) that are linked to a parent information object (see FIG. 1-3).

While Kunieda discloses information objects, or items, that hold information describing attributes of particular video segments, and through which the corresponding segments may be accessed, Kunieda does not disclose that each such item, or object, is *a duplicate of a portion of a corresponding one of said plurality of multimedia presentations*. Rather, the various information objects of Kunieda hold index information that is generated by applying various analysis algorithms and techniques (e.g., background color analysis, motion analysis, etc.) to the video stream, and/or by manually inputting information (e.g., regarding content, characters appearing in a particular scene, etc.) to populate the index objects (col. 11, lines 21-39). Video segments can subsequently be retrieved by performing searches of the video index based on the such search criteria as the format used to encode video segments, the replay time length, the persons appearing in a particular segment, the content of the segment, etc. (col. 15-16). The search queries, called "retrieval conditions", are composed of search terms that Kunieda refers to as "retrieval items" (see, for example, col. 15, lines 17-20, and col. 16, lines 35-38). These retrieval conditions identify relevant index information objects that correspond to video segments that later may be accessed. However, the index information objects that are identified are not duplicates of a portion of an actual video (or of some other multimedia presentation), as are Applicants' multimedia data items described in independent claim 1, but are simply text data entries held in objects that are arranged in a tree-like structure.

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The Examiner contended the statement in Kunieda of "having the retrieval information 201 corresponding to each of the retrieval items is identical or not" (col. 31, lines 34-36) discloses the Applicants' claim 1 feature of *one or more multimedia items being a duplicate of a portion of a corresponding one of said plurality of multimedia presentations*. As explained above, retrieval information 201 is an information object that holds text-data to facilitate searching the tree-structure index to locate a desired video segment (col. 14, line 64, to col. 16, line 35), and the retrieval items are the search terms that comprise the search queries (also referred to as "retrieval conditions") that a user enters to search the index (col. 15, lines 17-20). The Kunieda statement that the Examiner referred to is preceded by the statement that "when there are a plurality of retrieval items for segment information 104 as an object for retrieval, coincidence between the retrieval conditions and a scene in a video stream can be determined by making determination as to whether the segment information 104 having the retrieval information 201 ..." (col. 31, lines 30-35). Thus, the Kunieda statement the Examiner referred to merely provides that a particular segment information object, corresponding to a particular video segment, will be determined to match the search criteria (i.e., the retrieval items that constitute a retrieval condition) if the segment information in the object is identical to the retrieval items. The passage that the Examiner referred to, therefore, does not provide that the segment information object is an identical portion or *a duplicate of a portion of a corresponding one of said plurality of multimedia presentations*.

In the Advisory Action, the Examiner stated that Kunieda's teaching that "the contents 'news' for the retrieval item 'title' in the conditions shown in FIG. 25 is identical to the contents 'news' for the retrieval information 201T in the tree information in both the video index information 300A and video index information 300B" (col. 27, lines 45-49) meets the claimed limitations. As clearly stated by Kunieda and shown in FIGS. 25 and 26, "news" is the retrieval item or search term that matches or is identical to the information contained in the index for the title of Movies A and B. In a first instance, the search terms and index information in Kunieda are text items and are not *multimedia data items*, as recited in Applicants' claim 1. Additionally and as provided above, the matching of a search term to an index does not correspond with Applicants *providing ... multimedia data items*, where *each ... multimedia data item ... is a portion of a corresponding one of said plurality of multimedia presentations*.

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PAGE 22/26 * RCVD AT 1/13/2005 1:36:15 PM [Eastern Standard Time] * SVR:USPTO-EFXRF-1/2 * DNIS:8729306 * CSID:9727183946 * DURATION (mm-ss):11-38

Accordingly, since the combined teaching of Contois, Arons, and Kunieda does not teach providing one or more multimedia data items, *each of said one or more multimedia data items being a duplicate of a portion of a corresponding one of said plurality of multimedia presentations*, as recited in Applicants' independent claim 1, Examiner fails to provide a *prima facie* case of obviousness for at least for failing to show all the elements of the claimed invention in the combined teaching cited by the Examiner, as required by MPEP 2143.

Furthermore, Applicants submit that the Examiner has also failed to provide a *prima facie* case of obviousness for failing to provide a suggestion or motivation for combining the references cited by the Examiner, and/or for failing to show that there would be a reasonable expectation of success to combine the two references, as required by MPEP 2143.

Specifically, as provided in MPEP 2143.01, "If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious" (emphasis added). Further, MPEP 2143.01 states: "if the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification."

As explained in the Applicants' previous responses, Contois teaches a system and method for controlling a media playing device in which a user interacts with data fields displayed on a computer screen to choose music or video selections from a media database, where media playback buttons on the computer screen allow the user to control playback of music or video selections (col. 9 line 21 - col. 11 line 29; FIGS. 2-6). Selection of a particular item from one of the data fields available on a user interface causes the remaining data fields to display only items found in the music data base that are directly related to the selected item (col. 9, line 66 to col. 10, line 6). For example, selecting the music category "classical" from the listed items in the "categories" data field results in only data items related to classical music being displayed. Thus, selection of items in the data fields is accomplished in Contois through an interactive selection of one or more of the displayed items that results in the automatic display of related items in other data fields. The user can thereafter further select data items from the resultant listing of data items to achieve an even more refined listing of available data items. Once a user

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finally finds, through this interactive process, the presentation it wishes to access, the user may start playing that presentation (col. 12, lines 23-38 of Contois).

By stark contrast, selection of video segments is accomplished in Kunieda by inputting and launching search queries to find video index objects matching the search terms (col. 15, lines 6-26, and FIG. 8 of Kunieda). Although video index objects are arranged in a tree-like structure, and are therefore linked to parent objects, these objects are not otherwise logically linked to other objects in a manner that the selection of one object would result in a corresponding selection of related objects (or data items). Moreover, data items (i.e., information objects) are not displayed, and are therefore not available for user selection, but rather can only be accessed by performing a search using search queries.

Thus, in Contois a user can actively select different data items presented on the user interface that provide the user with more specific choices pertaining to the user's selection, thereby enabling the user to navigate its way to selecting a multimedia presentation. Conversely, in Kunieda a user can merely perform a search, based on retrieval conditions, that yield search results that may or may not correspond to what the user was looking for. Kunieda also does not present related data items in accordance with the user's selection of other data items. Accordingly, combining the teaching of Kunieda with Contois would entirely undermine Contois' interactive procedure for selecting the user's desirable multimedia presentation. The Kunieda teaching would thus modify Contois in a way that would wholly change the principle of operation of Contois and/or make it completely unsatisfactory for its intended purpose.

In the Advisory Action, the Examiner states that "the limitation 'present related data items in accordance with the user's selection of other data items' is not claimed in the claimed limitations." Applicants agree and suggest that the Examiner may have misinterpreted the above remarks. The Examiner is respectfully requested to consider the above remarks as a showing that the Examiner's proposed combination of Kunieda and Contois (as modified by Arons) would change the operation of Contois and/or render Contois unsatisfactory for its intended purpose. As such, the combination is insufficient under MPEP 2143.01 to render Applicants' independent claim 1 *prima facie* obvious and/or fails to provide a motivation to combine.

Applicants also submit that due to the incompatibility, there can be no reasonable expectation of success in attempting the proposed combination.

Applicants thus submit that Examiner fails to provide a *prima facie* case of obviousness for failing to show all the elements of the claimed invention in the cited combined teaching, and for failing to show a motivation to combine and/or reasonable expectation of success of the combined teaching. Applicants' failure to address other grounds, if any, upon which the *prima facie* case of obviousness fails should not be construed as an acquiescence to such other grounds, but rather a recognition by Applicants that such other grounds are moot given the failure to show a proper motivation to combine and/or reasonable expectation of success, and failure to show all the elements of the claimed invention in the cited combined teaching. Applicants thus traverse Examiner's 35 U.S.C. 103(a) rejection of independent claim 1, and consider independent claim 1 to be allowable. Claims 2, 4-10, 13-16 are also allowable as depending from an allowable base claim.

Independent claims 17, 25, 27, 43, 51, and 53, describe features similar to those described in Applicants' independent method claim 1, including, for example, the feature of *one or more multimedia item being a duplicate of a portion of a corresponding one of said plurality of multimedia presentations* [or of *said first media stream*]. For the reasons stated previously with respect to Applicants' allowable independent claim 1, Applicants traverse Examiner's rejection of independent claims 17, 25, 27, 43, 51, and 53, and consider independent claims 17, 25, 27, 43, 51, and 53 to be allowable. Since each of claims 18-24, 26, 28, 30-36, 39-42, 44-49, 52, and 54, depends from one of allowable independent claims 17, 25, 27, 43, 51, and 53, Applicants traverse the Examiner's rejections of such dependent claims, and consider claims 18-24, 26, 28, 30-36, 39-42, 44-49, 52, and 54 to also be allowable as depending from allowable base claims.

CONCLUSION

Applicants consider the Response herein to be fully responsive to the referenced Office Action. Based on the above Remarks, it is respectfully submitted that this application is in condition for allowance. Accordingly, allowance is requested. If there are any remaining issues or the Examiner believes that a telephone conversation with Applicants' attorney would be

helpful in expediting the prosecution of this application, the Examiner is invited to call the undersigned at (972) 718-4800.

Respectfully submitted,

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